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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/815,892 | 03/23/2001 | Verivada Chandru Chandresekaran | BSCO115540 | 7893 |

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EXAMINER

WILLSE, DAVID H

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3738

DATE MAILED: 09/16/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,892

Applicant(s)

CHANDRESEKARAN ET AL.

Examiner

Dave Willse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-24, 26-31 and 33-45 is/are pending in the application.
- 4a) Of the above claim(s) 17, 19-23 and 38-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 24, 26-31, 33-37 and 42-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 7/21/03 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Claims 17, 19-23, and 38-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4. The Applicant has not provided an updated listing of claims readable on the elected species (including claims added), as required in Paper No. 3: page 2, paragraph 3. Since the elected species does not appear to possess the feature that "a portion of the core contacts the vessel" (amended claim 17, last line) in view of Figure 5 and page 6, lines 20-22, of the specification, claims 17 and 38-41 have been withdrawn from further consideration.

Claims 42 and 44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 42, line 1, "the barrier *layer*" (emphasis added) lacks a proper antecedent basis. A similar error exists in claim 44.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 24, 26-31, 33, 34, 36, 37, and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alt, US 6,099,561. The outermost layer or barrier 80 is disclosed as being an oxide, hydroxide, or nitrate of a noble metal (column 11, lines 40-43; claims 21, 22, and 38; etc.), with examples being iridium oxide and titanium nitrate. Regarding claims 18, 26, and 27, the particular oxides, nitrides, and carbides were well known in the art and would have been obvious variants in view of their similar purposes (column 10, lines 1-13) and in the absence of

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any supposed criticality or advantage (in the Applicant's disclosure) of one material over another (*In re Kuhle*, 188 USPQ 9). Regarding claims 28-31: column 10, lines 23-26; Figure 2; etc.

Regarding claims 33, 34, and 36, the materials (column 7, lines 44-49) for the structural member 11 provide a fraction (albeit a small one) of x-ray absorption (column 2, lines 48-50; column 4, lines 13-14); alternatively, the core may be viewed as additionally comprising the layer 50 of noble metal. Regarding claim 37: column 3, line 31; etc.

Claims 18, 24, 27, 28, 33-36, 44, and 45 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Davidson, US 5,685,306: column 6, lines 7-10 and 40-47; column 7, lines 56-60; column 11, lines 59-64; column 12, lines 36-38 and 46-47; column 13, lines 25-28; column 14, lines 17-18 and 63-67; etc.

Claims 26, 29-31, 37, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davidson, US 5,685,306. Regarding claim 26, tantalum nitride, for example, would have been immediately obvious, if not inherent, from column 6, lines 9-10, and column 14, lines 17-18. Regarding claims 29-31, micro-pores or grooves or the like would have been obvious in order to help affix the optional medicament coating (e.g., column 7, lines 56-60). Regarding claim 37, a coronary stent would have been obvious from column 13, lines 14-15, and from the various disclosed examples pertaining to the treatment of the heart.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Particular attention is directed to column 14, lines 39-50, of US 6,174,330 B1.

The Applicant's remarks have been reviewed. As seen from the cited prior art, numerous metal oxides, nitrides, and carbides are used in the art, including several within the scope of the Applicant's claims. The Applicant alleges that "the Examiner provided no suggestion or

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motivation to modify Alt's materials to that of the claimed materials" (Paper No. 8, page 6, last paragraph). It is the Applicant who has provided no suggestion or motivation for supposedly favoring the presently claimed oxides, nitrides, or carbides over the previously claimed titanium nitride, for example; attention is again directed to *In re Kuhle*, 188 USPQ 9. Moreover, Alt is clearly open to other metallic oxides and nitrates which satisfy the criteria set forth in patent claim 22 or 38 or column 10, lines 1-4. The added rejections were necessitated by the altered scope of the claims (e.g., the deletion of means plus function language, the further limitations on materials, etc.). Therefore:

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (703) 308-2903. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Dave Willse
Primary Examiner
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